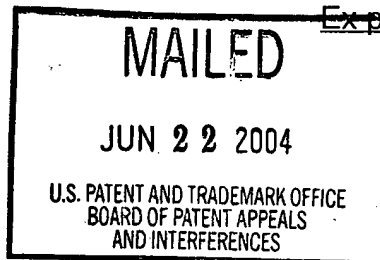


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**



Ex parte ALAN J. ROZLOSNIK, STEVEN R. DAVIS
and MARK A. DEPIETRO

Appeal No. 2003-0098
Application No. 09/398,182

ON BRIEF

Before COHEN, NASE, and BAHR, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 18, which are all of the claims pending in this application.

We REVERSE:

BACKGROUND

The appellants' invention relates to banking machines (specification, p. 1). A copy of the dependent claims under appeal is set forth in the appendix to the appellants' brief. The independent claims on appeal read as follows:

1. A method comprising the steps of:
 - (a) conducting at least one transaction at a deposit accepting machine;
 - (b) printing a receipt including indicia corresponding to the transaction with a printer in an interior area of the machine;
 - (c) extending a receipt intermediate of an exterior wall of the machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user;
 - (d) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
16. A method comprising the steps of:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and
 - (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member.
18. A method comprising:
 - (a) extending a printed receipt intermediate of an exterior wall of a deposit accepting machine and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user, wherein the exterior wall includes an opening, wherein the overlying member extends from generally above the opening to a generally downward facing edge positioned below the opening, wherein the aperture extends below the opening;
 - (b) moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member, wherein the receipt is moved generally downward by movement of the finger in the aperture, wherein the overlying member is disposed in proximity to the exterior wall such that a receipt extending

therebetween cannot be manually grasped adjacent the edge with fingers prior to moving the receipt by engagement with a finger through the aperture;
(c) subsequent to (b), manually grasping the receipt.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Caldwell	4,754,126	June 28, 1988
Imai et al. (Imai)	5,898,155	Apr. 27, 1999
McCall	6,112,981	Sept. 5, 2000

Claims 1 to 3, 5 to 8 and 10 to 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of McCall.

Claims 4 and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over Caldwell in view of McCall and Imai.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejections, we make reference to the answer (Paper No. 10, mailed June 3, 2002) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 9, filed April 8, 2002) and reply brief (Paper No. 11, filed June 26, 2002) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 18 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

In this case, the applied evidence (i.e., Caldwell, McCall and Imai) would **not** have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention for the reasons set forth in the brief and

reply brief. Method steps (c) and (d) of claim 1, method steps (a) and (b) of claim 16 and method steps (a), (b) and (c) of claim 18 are not taught or suggested by any of the applied prior art references. In that regard, we view the examiner's position that McCall's fuel dispenser 12 has a receipt dispenser, as indicated on page 9 of the answer, to be sheer speculation unsupported by the actual disclosure of McCall.¹

Since the claimed subject matter is not suggested by the applied prior art references for the reasons set forth above, we have no choice but to reverse the decision of the examiner to reject claims 1 to 18 under 35 U.S.C. § 103.

¹ While we agree with the examiner that receipt dispensers are known to exist on fuel dispensers at gas stations, none of the applied prior art references actually teach or suggest such a receipt dispenser. Instead of relying on McCall, the examiner should have cited and applied a prior art receipt dispenser (see In re Lee, 277 F.3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999)) if the receipt dispenser extended a printed receipt intermediate of an exterior wall of the fuel dispenser and an overlying member, wherein the overlying member includes an aperture therein sized for accepting a finger of a user; and moving the receipt in sandwiched relation between a finger extended in the aperture and the exterior wall to remove the receipt from between the exterior wall and the overlying member. In addition, it is not clear to us if the claimed "deposit accepting machine" is readable on a fuel dispenser that accepts debit and credit cards since the United States Patent and Trademark Office (USPTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellants' specification. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 18 under
35 U.S.C. § 103 is reversed.

REVERSED



IRWIN CHARLES COHEN
Administrative Patent Judge



JEFFREY V. NASE
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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